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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/782,131	02/19/2004	Rafail Zubok	532/3X2 CIP	5239
530 7590 03/31/2009 LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090				
EXAMINER COMSTOCK, DAVID C				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
03/31/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/782,131

**Applicant(s)**

ZUBOK ET AL.

**Examiner**

DAVID COMSTOCK

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3, 5-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) 20 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3, 5-7, 9-13 and 19 is/are allowed.
- 6) ☒ Claim(s) 8, 14-18 is/are rejected.
- 7) ☒ Claim(s) 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 April 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/29/09
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 January 2009 has been entered.

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires that new claims must be numbered consecutively beginning with the number next following the highest numbered claims previously presented. New claims 19, 21 and 22 were added but claim number 20 was skipped over. In addition, claims 21 and 22 depend directly or indirectly from claim 20 and are also objected for this reason. Accordingly, for purposes of examination, claim 20 will be withdrawn and claim 21 will be considered as depending from claim 19. Appropriate correction is required.

### ***Specification***

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction

of the following is required: The Specification should be amended to recite the amended language added to the claims. It is noted that the language appears to have proper support based on the description and figures, but the language must still be added to the Specification.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al. (6,113,637) in view of Michelson (6,139,550).

Gill et al. disclose an artificial disc replacement (ADR) device having a flange 34 and a retaining device 39 for retaining a pair of bone screws 37 in the device (see, e.g., Figs. 1-3 and col. 5, lines 32-39). The retaining device comprises a threaded attachment member. A head flange extends from the threaded attachment member and is abuttingly received against a side of the ADR flange. An outermost portion of the head flange is partially received over a portion of a pair of bone screws or prevent backout. Gill et al. disclose the claimed invention except for the concave shape and flexibility of the head. Michelson also discloses a device comprising retaining screws, e.g. 25, for bone screws (see, e.g., Figs. 12, 14 and 16 and col. 14, line 47 - col. 15, line 2). The retaining device comprises a convex, flexible head 23 to assist the locking

device in riding over the top of a bone screw head to facilitate a surgical procedure. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have provided the device of Gill et al. with a convex, flexible head on the retaining device, in view of Michelson, in order to assist the locking device in riding over the top of the bone screw head and facilitate the surgical procedure. It is noted that upon flexing, the convexity of the head would decrease such that the head would become flatter. The method of claim 8 is inherent in the device of the combination of Gill et al. and Michelson. Regarding method claims 8 and 14-18, the structural limitations therein have not been given patentable weight since they do not affect the actual steps of the method in a manipulative sense. Moreover, it would have been further obvious to have provided any desired number or configuration of stress reliefs (i.e. slots) in Michelson, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

***Allowable Subject Matter***

Claims 1, 3, 5-7, 9-13 and 19 are allowed. The subject matter of claims 21 and 22 would be allowable if amended to correct improper claim numbering and dependency. Note the comment above regarding the misnumbered claims.

### ***Response to Arguments***

Applicant's arguments filed 29 January 2009 have been fully considered but they are not fully persuasive.

Applicant's amendment positively bounding on all lateral sides the stress relief area, as now set forth in claim 1 overcomes the outstanding rejection of claims 1, 3, 5-7 and 9-13. New claim 19, reciting at least on circular stress relief area, surrounded by a solid portion, not centrally located, etc., as set forth in claim 19, is allowable for reasons discussed in the interview of record on 16 April 2008. Regarding the method claims, the structural limitations therein, including those added by amendment, have not been given weight inasmuch as and insofar as they do not affect the steps of the method in a manipulative sense.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/David Comstock/  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733